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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/748,370	12/27/2000	Yoshiyuki Ito	826.1654	3850

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EXAMINER
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ABEL JALIL, NEVEEN

ART UNIT	PAPER NUMBER
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2165

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/748,370

Applicant(s)

ITO, YOSHIYUKI

Examiner

Neveen Abel-Jalil

Art Unit

2165

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### **Remarks**

1. The Amendment filed on December 9, 2005 has been received and entered. Claims 1-51 are pending.

### ***Claim Objections***

2. Claims 1, 2, 3, 4, 6, 7, and 8 are objected to because of the following informalities:
3. Applicant's recitation of "for extracting information" in claim 1 constitute intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably, therefore carry no patentable weight.
4. Claim 3, line 2, recite "can be" is passive and should be changed to recite something more firm and definite i.e. "is".
5. Independent claim 1 initially recites the limitation "an XML format" in the body of the claim, later on, dependent claims 2, and 3, introduce another statement of "an XML format" making it vague and unclear to the Examiner if a new XML formatting is taking place after the initial process or if the reference remains to the prior XML format thereby lacking sufficient antecedent basis for this limitation in the claim.

6. Independent claim 4 initially recites the limitation "a database" in line 3, later on, recites "a database" again in the body of the claim, line 6, making it vague and unclear to the Examiner if a new database is being referenced or if the reference remains to the prior database thereby lacking sufficient antecedent basis for this limitation in the claim.

7. Independent claim 5 is directed to "A method" in the preamble, later on, dependent claims 6-8, introduce the statement of "A method" making it vague and unclear to the Examiner if a new method separate from the proceeding takes place after the initial process or if the claims are meant to be independent claims and therefore should be written as such. Claims 6-8 lack sufficient antecedent basis.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1, 4, and 5 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claim 1 preamble recites "an information extracting device for" performing a functionality without ever mentioning the "device" as being a tangible computer device storing software program "executed" or "processed" to realize the intended functionality, there are no components or elements recited to the device, and there's no hardware

included in the device to perform the functionality. Moreover, the mere recitation of “for” is intended use and does not cause any functionality to occur in the device. The claim language should be amended to be more direct and positive.

11. Claim 4 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Independent claim 4 preamble recites “a program stored on a computer medium” without ever mentioning the program being “executed” or “processed” to realize its functionality.

12. Claim 5 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 5 is not statutory because it merely recite one computing step without producing any tangible result and/or being limited to a practical application (see MPEP 2106 IV.B.2.(b)). The definitions given in the specification for a system is broad enough so as to not include a practical application within the technological arts, and no tangible result is produced in the claims. The claims should entail transformation of article or material to a different state or thing with final results achieved “useful, tangible, and concrete”. The claims should be amended so that some kind of output is required and/or so a tangible result is produced.

For instance, in claim 5, the final limitaion of “converting” has not transformation and produces no real world results/output. Furthermore, although, reciting “a database” in the preamble; the body of the claim has no recitation of the steps being stored or transformed on a

computer or any other hardware, it merely recite “referring to the database” which could be just done visually without the need for computer interaction, execution, or processing.

***Claim Rejections - 35 USC § 112***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1, 4, and 5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps.

See MPEP § 2172.01. The omitted steps are:

15. The preamble of claim 1 recites “An information extraction device” however in the body of the claim 1, the device is directed to “calling a function... for converting...referring... returning”. There’s no claim to the actual “extraction” taking place or what device feature is performing the “extraction”. There’s no claim to how the device is interrelated with the performance of the “function” or whether the “function” is stored and preformed by software in the device. There’s no claim to the storage of previously sent /received requests.

The claim fails to interrelate essential elements of the invention as defined by applicant(s) in the specification page 2, lines 16-25, and page 3, lines 8-16 specifically the steps between “calling a function” and “converting” ...and “returning results”. These steps further interrelating it to the preamble are missing. There’s no mention of the “extraction” taking place anywhere in the body of the claim as such how does the claim achieve its sought out purpose of being “an information extraction device”?

Furthermore, the device components of “XML operator function 5”, “browser 1”, server 2”, and “XML generation function 4” appears to be missing in light of the specification figure 1. One or both those components deemed necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

16. Claim 4 preamble recite “for controlling a server to perform” without any reference to how the server is actually performing the process since there’s no mention of the “server” at all in the body of the claim making it hard to understand its functionality or its place with respect to the database or the information extraction device. There’s no mention of how theses processes are tied or preformed with respect to the server.

Furthermore, the device components of “XML operator function 5”, “browser 1”, server 2”, and “XML generation function 4” appears to be missing in light of the specification Figure 1, and specification page 6, lines 6-21. One or both those components deemed necessary structural cooperative relationships of elements described by the applicant(s) as necessary to practice the invention.

17. Claim 5, recite the single step of “converting” without any reference to what is performing the “converting” step or to how the “converting” is taking place. There’s no tie-in to any hardware performing the “functionality” to realize the “converting” step, it can easily be implemented on paper.

The claim fails to interrelate essential elements of the invention as defined by applicant(s) in the specification page 2, lines 16-25, and page 3, lines 8-16 specifically the steps between

“extracting” ...then “converting” steps. The steps of “sending a request”...”function call up” ...”extracting information”...”returning information” are missing in order to interrelate it to the preamble. When did the “extracting” step place?

18. Claims 2-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2-3 recite the limitation "the generated requests in an XML format". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

19. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

20. Claims 1-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Anderson et al. (U.S. Patent No. 6,510,434 B1).

As to claim 1, Anderson et al. discloses an information extraction device for extracting information corresponding to a request from a database, comprising:



a function called up from application software, for converting a plurality of kinds of requests into requests in an XML format by referring to a database and returning results and returning results of the requests from the database (See column 14, lines 53-67, wherein “application” reads on “query requests sent by client device”, also see column 15, lines 1-2).

As to claims 2, and 3, Anderson et al. discloses wherein a list of requests related to the generated requests in an XML format that can be arbitrarily selected and set, is linked and provided (“list of request” is deemed to be “the requests themselves” there’s no distinction made here to the contrary).

As to claim 4, Anderson et al. discloses a computer-readable storage medium on which is recorded a program for controlling a server to perform a process comprising:

extracting information corresponding to a request from a database as an information extraction device (See column 14, lines 53-62, wherein “extracting” reads on “parsing”, also see column 15, lines 1-2);

converting a plurality of kinds of requests into requests in an XML format (See Figure 6A, flow chart showing steps for receiving request.. identifying XML related to request, combining the XML with request.. then delivering the results) by referring to a database as a function called up from application software (See Figure 1B, shows plurality of applications having access to database, and see column 9, lines 54-58, teaches application is a search retrieval application to find information);

returning the information extracted from the database by the request (See column 9, lines 14-17, wherein “returns” reads on “access and locate information stored in the database”).

As to claim 5, Anderson et al. discloses a method for extracting information from a database in response to a request for the information, comprising:

converting at least one of a plurality of kinds of requests into a an extensible markup language format referring by to the database (See Figure 6A, flow chart showing steps for receiving request.. identifying XML related to request, combining the XML with request.. then delivering the results, also see Figure 1B, shows plurality of applications having access to database, and see column 9, lines 54-58, teaches application is a search retrieval application to find information).

As to claim 6, Anderson et al. discloses wherein said converting is performed in a function called up from application software (See column 14, lines 53-67, wherein “application” reads on “query requests sent by client device”, also see column 15, lines 1-2), and

wherein said method further comprises returning results in the extensible markup language format from the function the application software (See column 14, lines 53-67, wherein “application” reads on “query requests sent by client device”, also see column 15, lines 1-2).

As to claim 7, Anderson et al. discloses wherein the application software and the function are executed by a server having access to the database (See column 14, lines 49-52).

As to claim 8, Anderson et al. discloses wherein the database stores XML tags in tables, including at least one table indicating at least one relationship between data in independent tables by defining at least one relationship between the XML tags in the independent tables (See column 14, lines 58-66, wherein “independent table” reads on “metafile” indexes XML tags).

### ***Response to Arguments***

21. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neveen Abel-Jalil whose telephone number is 571-272-4074. The examiner can normally be reached on 8:30AM-5: 30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Gaffin can be reached on 571-272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/748,370

Page 11

Art Unit: 2165

A handwritten signature in black ink, appearing to read 'Niveen Jalil', with a large, sweeping flourish extending from the end of the name.

Neveen Abel-Jalil

March 2, 2006